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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/939,418 | 08/24/2001 | Daniel J. Dove | 10015055-1 | 4205 |

7590 05/31/2006

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Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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| EXAMINER |
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HSU, ALPUS

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| ART UNIT | PAPER NUMBER |
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2616

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,418

Applicant(s)

DOVE, DANIEL J.

Examiner

Alpus H. Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The drawings are objected to under 37 CFR 1.83(a). The drawings **must** show every feature of the invention specified in the claims. Therefore, the claimed “apparatus”, “media access controller”, “physical layer device”, “gigabit media independent interface”, “ten bit interface”, and “means for multiplexing” as in claim 1, “means for controlling” as in claim 4, “media interface”, “media access controller”, and “physical layer device” as in claim 8, “media access controller”, “physical layer device”, “gigabit media independent interface”, and “ten bit interface” as in claim 13, all must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the claim is rejected as vague and indefinite since it recites only a single means (i.e. means for multiplexing, and for selectively mapping) and thus encompasses all possible means for performing a desired function. See *Ex parte Bullock*, 1907 C.D. 93; 127 O.G. 1580.

In claim 1, line 8, claim 13, line 9, it is unclear as to what is intended to be the claim limitation for reciting "a significantly lesser number". How much is considered to be significantly lesser number?

In claim 3, line 1, "the clock rate", claim 4, line 2, "the clock signal", claim 5, line 1, "the clock signal", each lacks antecedent basis.

In claim 8, lines 6-7, "said clock signal" lacks antecedent basis.

In claim 12, line 2, it is unclear as to what "CRS" and "COL" signals are or what each stands for.

3. Claims 1-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

4. Applicant's arguments filed March 16, 2006 have been fully considered but they are not persuasive.

In the remark, regarding the objection to the drawings as failing to show every feature of the invention specified in the claims, the applicant argued that the drawings do illustrate the subject matter of the claims by referring to Fig. 1, which shows an interface

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being an apparatus for interfacing a media access controller (MAC) and a physical layer device (PHY) which are terms of art that are known to engineers of ordinary skill in the networking art. The applicant also referred to the exhibits in the Declaration of Daniel J. Dove dated December 5, 2005, which include the system diagram which is the subject of Fig. 1 of the present application, as well as the timing diagrams which are shown in Fig. 2., which was submitted in connection with the response to the prior office action.

The examiner disagrees since the submission of the declaration with exhibits cannot be considered as part of the specification disclosure. By simply arguing that all means are well known to those people with ordinary skill in the art is not sufficient to overcome the objection. The applicant is still required to show the “media access controller”, “physical layer device”, “gigabit media independent interface”, “ten bit interface”, and “means for multiplexing and selectively mapping” as in claim 1, “means for controlling” as in claim 4, “media interface”, “media access controller”, and “physical layer device” as in claim 8, “media access controller”, “physical layer device”, “gigabit media independent interface”, and “ten bit interface” as in claim 13.

Furthermore, the applicant also argued that “CRS” and “COL” signals are simply signals that are applied during operation of the media interface, which are described particularly at the bottom of Table 1 on page 4 as well as at lines 2-4 of page 4.

The examiner also disagrees since the description of “CRS” and “COL” signals as described at the bottom of Table 1 on page 4 and at lines 2-4 of page 4 were merely repetition of the claim language, it is still unclear as to what “CRS” and “COL” signals are or what each stands for.

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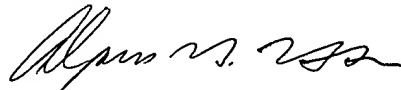
In view of the above reasoning, the examiner believes that the objection to the drawing and the 112 rejection regarding claim 12 should be sustained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHH



Alpus H. Hsu
Primary Examiner
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